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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,848	02/22/2002	Michael Musarella	87185-3300	7571
28765	7590	10/18/2006	EXAMINER	
WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006				ELKINS, GARY E
		ART UNIT		PAPER NUMBER
				3782

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/079,848	MUSARELLA ET AL.
	Examiner	Art Unit
	Gary E. Elkins	3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 July 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,6-12 and 14-45 is/are pending in the application.
- 4a) Of the above claim(s) 10,18-22,29-31,33-37 and 42 is/are withdrawn from consideration.
- 5) Claim(s) 6-8,12,14,15,28,43 and 44 is/are allowed.
- 6) Claim(s) 1,2,9,11,16,17,23-27,32,38-41 and 45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 11, 23-27 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Gagne. Gagne discloses a first support member 118, second support member 102 connected to the first support member at a connection portion 110 and a holding member 109 mounted to support member 102. No distinction is seen between the holder claimed and that shown in Gagne as a result of the claimed intended use with a handheld tool, i.e. the holder 109 of Gagne is considered capable of holding a handheld tool of like size to the holder. It is noted that no distinction is seen between the tool holder claimed and that of Gagne as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture. With respect to claim 11, note is made of the recess within element 114 and the corresponding shaped portion 112 of the tool holding member. With respect to claims 25 and 26, note is made of the connection portion 110 of Gagne which includes an extension and a recess which are respectively locked into position via the pivot pin.

3. Claim 9 is rejected under 35 U.S.C. 102(a) as being anticipated by Musarella et al (fig. 7 emb). Musarella et al discloses a first support member 12LRC, 12RRA, 12A, second support

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member 12LF or 12RF connected to the first support member at a connection portion 12LM or 12RM and a holding member 314A mounted to one of the support members 12RF and 12LF. It is noted that no distinction is seen between the tool holder claimed and that of Musarella et al as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture. Musarella et al is considered to include legs 12LRA, 12RRA extending along more than half of the height of the first support member as claimed. With respect to the newly added limitation that the support members are made of plastic, note is made of col. 5, lines 25-28 which indicates plastic as being one material from which the tool holder in Musarella et al is made.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn '342 in view of Gagne. Kahn '342 discloses a tool holder including first support member 10b and second support member 10a connected to the first support member at connection portion 10c. Tool holding members 30, 40 are mounted to the second support member 10b and are considered capable of holding a hand-held tool having a diameter of at least $\frac{1}{2}$ inch. With respect to claim 17, each tool holding member is considered to include a recess capable of holding the handle of a hand-held tool. Kahn '342 does not disclose formation of the first and second support members from pieces of separate construction that are joined in a fixed position.

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Gagne teaches that it is known to make a fastening clip by joining two separate portions at a fixed hinge position. It would have been obvious to make the clip 10 in Kahn '342 as a two piece clip joined at a fixed hinge as taught by Gagne since the clip of Gagne allows easier formation from two flat molded sections eliminating the need for bending the material. Both type of fastening clips are well known in this art. It is noted that no distinction is seen between the tool holder claimed and that of Kahn '342 as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture.

6. Claims 1, 2, 32, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skaggs in view of Gagne. Skaggs discloses a holder including first support and second support members 16 connected to each other at connection portion 36. Holding member 32 is mounted to the second support member. Skaggs does not disclose formation of the first and second support members from pieces of separate construction that are joined in a fixed position. Gagne teaches that it is known to make a fastening clip by joining two separate portions at a fixed hinge position. It would have been obvious to make the clip in Skaggs as a two piece clip joined at a fixed hinge as taught by Gagne since the clip of Gagne allows easier formation from two flat molded sections eliminating the need for bending the material. Both type of fastening clips evidenced in Skaggs and Gagne are well known in this art. No distinction is seen between the claimed holder and that shown in Skaggs as a result of the claimed intended use with a handheld tool, i.e. the holder of Skaggs is considered capable of holding a handheld tool of like size to the holder. It is noted that no distinction is seen between the tool holder claimed and that of Skaggs

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as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture.

7. Claims 1, 2, 11 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn '449 in view of Gagne. Kahn '449 discloses a first support member 10b, second support member 10a connected to the first support member at a connection portion 10c and a holding member 30 mounted to support member 10a. Kahn '449 does not disclose formation of the first and second support members from pieces of separate construction that are joined in a fixed position. Gagne teaches that it is known to make a fastening clip by joining two separate portions at a fixed hinge position. It would have been obvious to make the clip in Kahn '449 as a two piece clip joined at a fixed hinge as taught by Gagne since the clip of Gagne allows easier formation from two flat molded sections eliminating the need for bending the material. Both type of fastening clips as evidenced in Kahn '449 and Gagne are well known in this art. No distinction is seen between the holder claimed and that shown in Kahn '449 as a result of the claimed intended use with a handheld tool, i.e. the holder of Kahn '449 is considered capable of holding a handheld tool of like size to the holder. It is noted that no distinction is seen between the tool holder claimed and that of Kahn '449 as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture. With respect to claim 11, note is made of the recess 11 or 23 and the corresponding shaped portion 12, 30a of the tool holding member.

8. Claims 1, 2, 32, 38, 39, 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musarella et al (fig. 7 emb) in view of Gagne. Musarella et al discloses all structure of the claimed holder except formation of the first and second support members from

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pieces of separate construction that are joined in a fixed position. Gagne teaches that it is known to make a fastening clip by joining two separate portions at a fixed hinge position. It would have been obvious to make the clip in Musarella et al as a two piece clip joined at a fixed hinge as taught by Gagne since the clip of Gagne allows easier formation from two flat molded sections eliminating the need for bending the material. Both type of fastening clips as evidenced in Musarella et al and Gagne are well known in this art. It is noted that no distinction is seen between the tool holder claimed and that of Musarella et al as a result of the claimed intended injection molding method. The patentability of a product is not dependent upon its intended method of manufacture. Musarella et al is considered to include legs 12LRA, 12RRA extending along more than half of the height of the first support member as claimed.

Allowable Subject Matter

9. Claims 6-8, 12, 14, 15, 28, 43 and 44 are allowed.

Response to Arguments

10. Applicant's arguments filed 18 July 2006 have been fully considered but they are not persuasive.

With respect to the patent to Gagne, the remarks assert that the new limitation regarding formation of the first and second members from separate pieces and joined to each other in a fixed position define over the reference. In response, Gagne discloses a clip formed from two pieces and joined at a fixed hinge. No distinction is seen between the holder of Gagne and that set forth in claims 1, 2, 11, 23-27 and 32.

With respect to the holders disclosed in Kahn '342, Skaggs, Kahn '449 and Musarella et al, it is agreed that none of these constructions involve a two piece construction. However, it is

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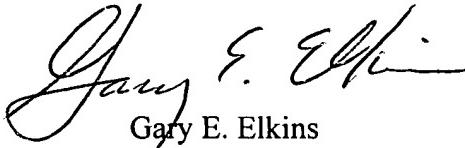
believed that use of a two piece clip, as is a common construction in this art, would have been an obvious substitution for the one piece clips evidenced in these references.

With respect to claim 9, as indicated above, Musarella et al is considered to anticipate the holder being claimed.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Gary E. Elkins
Primary Examiner
Art Unit 3727

gee
16 October 2006